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Date of Signature and Deposit: April 24, 2007 Michael J. McGuire
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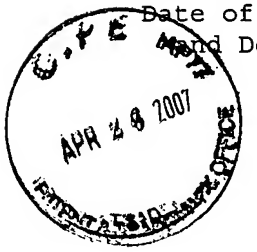


PATENT

Dkt No. 180009.91206B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Before the Board of Patent Appeals and Interferences

Ex parte JON R. STIEBER, THOMAS P. ADAMS, ROBERT L. ZWIEG and WILLIAM R. KIRKMAN

Appeal No.: 2006-2607 Tech. Center: 3600

Appl. No.: 10/004,738

Filed: December 4, 2001

For: AUTOMATIC CASH HANDLING MACHINE WITH WIRELESS NETWORKED I/O DEVICES

REQUEST FOR REHEARING

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Appellants, Jon R. Stieber et al., have reviewed the Board's Decision on Appeal of February 27, 2007, and hereby request a rehearing under 37 C.F.R. §41.52 and a modification of the Board's decision as follows:

1. Appellants understand the Board's decision on the rejection under 35 U.S.C. §112, paragraph 2, to be a withdrawal of the final rejection on this ground, which withdrawal is gratefully acknowledged.

2. The Board's remand of claim 21 for further prosecution is also gratefully acknowledged.

3. The Board's rejection of claims 2-9 and 15-21 over Amos, Watanabe and Richardson for obviousness under 35 U.S.C. §103(a) is in error under the statute either before or after the anticipated Supreme Court decision in *Teleflex, Inc. v. KSR Int. Co.*, 119 Fed. Appx. 282 (Fed. Cir. 2005), *cert. granted*, 126 S. Ct. 2965, 165 L. Ed. 2d 949 (2006) *sub. nom. KSR International Co. v. Teleflex, Inc.* The rejection under 35 U.S.C. 103(a) should therefore be reversed, thereby making the issue on dependent claim 21 moot.

GROUNDS IN SUPPORT OF THE REQUEST FOR REHEARING

GROUND 1: The factual findings in the Board's decision in determining the content of the prior art are in error or are immaterial under 35 U.S.C. 103(a). Substantial findings of this type are required to reject the claims under 35 U.S.C. 103(a), even post-*KSR*. The findings do not provide substantial evidence for the decision under the standard set forth in 5 U.S.C. §706 (2). *In re Lee*, 277 F. 3d 1338, 1342 (Fed. Cir. 2002).

GROUND 2: The Board does not correctly find correspondence in the references for each and every material limitation of the claims and, therefore, has not made out a *prima facie* case of obviousness under 35 U.S.C. 103(a), which would be required post-*KSR*.

GROUND 3: With respect to the dependent claims, the Board commits the error of "double reading," i.e., reading two different limitations in two related claims (independent and dependent) on a single element in the references and this is in error as a matter of law even post-*KSR*.

GROUND 4: The Board incorrectly finds a basis to combine teachings of Amos and Richardson based on an incorrect understanding of the field of the invention vs. the field of the Amos reference and the Richardson reference.

Based on grounds 2, 3 and 4, the Board's decision is not in accordance with the law of 35 U.S.C. 103(a) under 5 U.S.C. 706(2). *In re Lee*, 277 F. 3d 1338, 1342 (Fed. Cir. 2002).

GROUND 1: THE FACTUAL FINDINGS IN THE BOARD'S DECISION IN DETERMINING THE CONTENT OF THE PRIOR ART DO NOT PROVIDE SUBSTANTIAL EVIDENCE FOR THE DECISION.

1. The Board acknowledges that the grounds of rejection under 35 U.S.C. §103 were not set forth in the Examiner's final action or the Answer other than incorporation by reference of material from an Office Action of April 21, 2004, but the Board goes on to provide a new rationale for applying the references *sua sponte*.

2. The Board said in its decision at page 3, line 22 - to page 4, line 5:

> We first note that the Examiner has referred, only indirectly to the prior Office action without fully restating the point relied on in the Answer, contrary to the requirements of *the Manual of Patent Examining Procedure (MPEP)* §1207.02. Even more problematic, the Examiner did not even set forth the reasoning behind the rejection in that final Office action, but only set forth two actions prior to that in (sic: including) the Final Rejection mailed April 21, 2004. We advise the Examiner that the technology known as cut and paste that could have put the Answer in compliance with the MPEP. "Judges are not like pigs, hunting

for truffles buried in briefs." *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 13 12, 1320,78 USPQ2d 1097, 1 103 (Fed. Cir. 2006).

3. The Final Rejection mailed April 21, 2004, set forth the final rejection as follows:

> Claims 2-4, 15, 16 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Amos in view of Watanabe, both cited herewith. Amos discloses a first machine (our note: an ATM) that accepts coins and banknotes and a second machine (our note: an ATM) that accepts coins and banknotes. The first and second machines (Our note: two ATM's) communicate over the Internet and/or over a wireless network (Our note: serially and not in parallel). Amos does not disclose that the first and second machines sort the coins and banknotes that they receive. Watanabe discloses ATMs that receive coins and banknotes and sort them so that they may later be dispensed. It would have been obvious to one of ordinary skill in the art in view of the showing and teaching of Watanabe to provide the machines of Amos with means to sort the coins and banknotes so that they may later be dispensed. (Our emphasis.)

4. The Board's decision evolves from the "two machines" of Examiner Bartuska, which were two ATM's, to a first coin processing device and a second note processing device in one ATM, which are said to be taught by either Amos or Watanabe. This is a new rationale for applying the references.

5. This is further seen in the Board's findings on page 6, lines 11-21, of the Board's decision, where it is said:

> Each of Amos' ATM's in fig. 2 contains machines for accepting and distributing notes and coins and each ATM has a keyboard and display (col. 1, line 66, col. 2, line 4 and col. 2, lines 29-37). (Our emphasis.)
>
> Amos' currency (cash) inserted or fed into the ATM becomes reusable in the device. The deposited amount is tallied and settled and then recycled into the cash inventory available to dispense. (col. 1, lines 57-61). (Finding 2) (Our emphasis.)
>
> Amos' device consists of a cash note accepting/dispensing device, coin accepting/return device coupled to a display unit, data input devices and a printer /dispenser that utilizes a computer/microprocessor and a modem for control and communication to multiple such devices and/or a centralized database for transactions, accounting and inventory control (col. 2, lines 29-37). (Finding 3) (Our emphasis.)

6. Although Amos asserts an ability to recycle cash in col. 1, lines 57-61 (Finding 2), there are no machine parts disclosed in Amos for performing this function. Amos discloses in its claim 1 that the currency accepting means is separate from the currency dispensing means, and that the coin accepting means is separate from the coin dispensing means to provide "a plural of said money transfer devices." (Amos, col. 3, lines 42-50.)

7. To the extent that the Board finds that Amos describes an ATM subassembly for both accepting and dispensing notes and an ATM subassembly for both accepting and dispensing coins, this is not disclosed in Amos. The factual finding is without substantial evidentiary support in the record and is not supported by the Examiner's findings in the action of April 21, 2004.

8. Next, the Board makes the following finding at page 6, lines 21-24:

> Amos uses the ATM's by telephonic, *wireless,* or other type of network, available 24 hours a day, as sender, receiver and dispenser (A or B) of funds interchangeably (col. 2,1ines 37-41).

9. This finding is an over-generalized statement of Amos' network types and is immaterial. The Board further says at page 10, lines 3-8: "Although Amos does not show the network operating according to a network standard for locally distributed wireless networks operating without servers, it does show that any network system may be used. A network standard for locally distributed wireless networks operating without servers is a species that would immediately be envisaged within the taught genus of all network systems because of its simplicity." (Our emphasis.)

10. Amos must communicate over long distances to a host computer because ATM's are generally distributed over a wide geographic area. The Amos wireless communication is in the nature of a telephone cellular network or a satellite network which are 1) long range wireless networks requiring 2) high power of transmission, 3) FCC-licensed operation and 4) relay towers and elaborate servers and networking equipment. The present invention uses 1) a short range wireless network operating with 2) relatively low power, 3) operating in the non-FCC-license frequency band, and 4) without servers and expensive networking equipment. The genus of "all networks" established by the Board opinion is without any technical basis in the record. One of ordinary skill in the art learns nothing material about low cost, local wireless networks in this technical environment from

consulting technical descriptions on satellite and cellular networks. According to the USPTO web site database, the USPTO has granted at least 24,000 U.S. patents with the term "network" in the title and 102,818 U.S. patents with the term "network" in the claims. There must be some patentable distinction between different networks, which is contrary to the Board's finding of a "taught genus" of networks.

11. The fact finding of a coin handling machine separate from and wirelessly communicating with a note handling machine with the features recited in the claims is without substantial, credible evidence in the record.

12. In the present invention, the coin handling and note handling devices are each to have radio communication ability either explicitly or inherently (See Summary of the Invention, paras. 0007 and 0008, claim 15: "through wireless communication from these respective devices")

13. In this respect, there is no disclosure in either Amos or Watanabe of providing each coin handling device and each note handling device in one ATM with their own respective wireless communication because they are assembled in the same machine. The network communication in Amos and Watanabe is on a "per ATM" basis and not on a coin device basis or a note device basis. A common network interface operates for both coin and note parts of the ATM machine in Amos. So, there is no communication between a coin device in one ATM and a note device in another ATM, or in the same ATM.

14. The Board finds that Watanabe shows a separate coin receiving and dispensing device and a separate note receiving and dispensing device (Board's decision, page 8, lines 1-3). There is no support in the Watanabe to conclude that the subassemblies in Watanabe could function as a stand-alone coin

receiving/sorting/ dispensing device and a stand-alone note receiving/sorting/dispensing device with wireless communication between. There is no motivation to wirelessly communicate between two devices in the same ATM machine.

15. Watanabe's Abstract is instructive in reciting the integration of its subassemblies as follows:

> A cash handling machine includes a housing having an aperture through which cash is put in, a bank note conveyor, a bank note sorter for sorting the bank notes conveyed by the bank note conveyor according to type of bank notes, a coin conveyor, and a coin sorter for sorting the coins conveyed by the coin conveyor according to type of coins. The machine has a single cash receiver for receiving both bank notes and coins put in through the aperture, a bank note feeder connected to the single cash receiver for taking out the bank notes from the single cash receiver and for feeding the bank notes to the bank note conveyor, and coin feeder connected to the single cash receiver for taking out the coins from the single cash receiver and for feeding the coins to the coin conveyor. (Our emphasis.)

16. Thus, there are four or more subassemblies in Watanabe for accomplishing these tasks including: a common coin/note intake feeding device, a coin sorter and coin receptacles per denomination and some apparatus for dispensing the coins from the receptacles, and three additional subassemblies for notes. The coin system and note system are integrated to some extent in Watanabe and there is no showing in the Board's decision why one of ordinary skill in the art would separate the subassemblies in an ATM and provide them with built-in wireless communication capability.

17. The Board cites Richardson for the following findings on page 8, lines 8-16:

> Richardson shows that two different devices may communicate over short ranges wirelessly (col. 2, lines 3-13). This is a notoriously old and well known means of communication between devices. Richardson shows that the wireless communication may occur over infrared or radio media (col. 2, lines 3-13), the latter of which may rely on Bluetooth technology in the 2.4 - 2.5 GHz portion of the radio frequency spectrum using hop frequencies col. 3, line 58 - col. 4, line 8). Richardson shows that Bluetooth in particular may be set for 10-100 meters distance apart use (col. 4,lines 1-8).

18. These findings are nothing more than citing the existence of the Bluetooth technology. Richardson was filed in 1999, claiming priority in 1998. The present application was filed in 2001, claiming priority to 2000. There is nothing "notoriously old" in comparing Richardson or the basic Bluetooth technology to the claimed invention. These are largely contemporaneous developments.

19. The Board decision on page 8, line 8, says that Richardson shows wireless communication between two different devices. Richardson shows communication between a display and a laptop processing unit, which are part of the one and the same computer, since I/O devices like displays are parts to complete a basic computer. The present invention claims communication expressly or inherently between two computerized pieces of equipment (a note handling device and a coin handling device, for example) and a visual display. Richardson is not cited by the Board as analogously disclosing communication between two computers and one display. Communication between a processor and

a visual display is known, but it is immaterial to the legal issues raised by claim 15, so the facts cited from Richardson do not provide substantial evidence for rejecting the claims.

GROUND 2: THE BOARD DOES NOT CORRECTLY FIND ANTECEDENT BASIS IN THE REFERENCES FOR EACH AND EVERY MATERIAL LIMITATION OF THE CLAIMS TO MAKE OUT A *PRIMA FACIE* CASE OF OBVIOUSNESS.

20. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); *see CFMT, Inc. v. YieldUp Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003). All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

21. It is believed that the Board would essentially agree that this legal standard was not met in the Examiner's final action (see paragraph 2 above).

22. The present claim 15 claims the following:

> "a first cash handling device for . . . communicating note totals . . . through a network,
>
> . . .
>
> "a second cash handling device for . . . communicating coin totals to . . . a network;
>
> . . .
>
> "wherein the first cash handling device and the second cash handling device provide a cooperative cash management system in which the totals for notes and coins, respectively, are brought together through wireless communication from these respective devices within a range of no more than 100 meters from each other and are displayed on at least one of the first cash handling device, the

second cash handling device or a third device operating as a visual display no more than 100 meters from one of the first the first cash handling device and the second cash handling device."

23. This means that two machines are communicating note totals and coin totals to a display either as part of one of the machines or as a third device. Richardson shows only a processing part of a computer communicating with an I/O device of the same computer. This does not establish the relationship of three devices or two computers communicating with each other as recited in claim 15.

24. The Board has not found all of the limitations of claim 15 of a first cash handling device and a second cash handling device separated by sufficient distance that wireless communication would be deemed necessary. It has not found a separate first cash handling device and a separate second cash handling device each with radio capability to combine coin totals from one machine and note totals from another machine on one display.

25. ATMs convey consumer account information as to how much is deposited or dispensed, but do not break down and transmit totals separately by notes and coins in these accounts for display to the customer. The general finding on page 7, lines 7 to 11, concerning inventorying of deposited amounts is not substantial evidence to supply the limitations found in claim 15 concerning transmitting coin totals and note totals from two machines to a display.

26. With respect to claim 19, the Board decision is also factually incorrect. The fact that Watanabe sorts coins and notes does not mean that Watanabe accepts unsorted notes and coins in separate devices because Watanabe has a common input

device for notes and coins. (See Watanabe Abstract, line 7-9: "The machine has a single cash receiver for receiving both bank notes and coins put in through the aperture.")

GROUND 3: WITH RESPECT TO THE DEPENDENT CLAIMS, THE BOARD DECISION IS BASED ON THE ERROR OF "DOUBLE READING," I.E., READING TWO DIFFERENT LIMITATIONS IN TWO RELATED CLAIMS (INDEPENDENT AND DEPENDENT) ON A SINGLE ELEMENT IN THE REFERENCES AND THIS IS IN ERROR AS A MATTER OF LAW.

27. The Board's decision also falls into the practice of reading two different claim limitations on the same element in the prior art (double reading) when it considers claims 2 and 16 and claims 3 and 18, which depend directly or indirectly from claim 15.

28. Claim 2 recites:

The cash management system of claim 15, further comprising I/O devices, wherein the I/O devices communicate through the first wireless communication network, and wherein the I/O devices are selected from a group consisting of: a printer, a scanner, a visual display, a keyboard, a cell phone, a pager, a personal digital assistant and a personal computer.

29. What Richardson shows is a single visual display, so if Richardson is to be read as providing the I/O device of claims 2 and 16, it does not suggest a second display I/O device already recited in claim 15. In claims 2 and 16, the Board is reading two claim limitations on the same visual display of Richardson.

30. The same error applies to claims 3 and 18. These claims add the subject matter wherein at least one of the cash handling devices is electrically connected to a second network selected from a group consisting of: the Internet, an intranet, a

LAN and a WAN. This network is not serially connected to the wireless local network as would be the case in Amos if two networks were present. The Board's response on these claims does not address the issues on this point which were argued in the Brief on Appeal.

31. Under the "broadest reasonable interpretation" rule governing interpretation of claims in the USPTO, the USPTO cannot adopt an interpretation of terms in the claims in a manner inconsistent with 1) the specification, 2) the other claims 3) the prior art or 4) the understanding of one of ordinary skill in the art. Therefore, double reading of elements in the claims on poorly identified individual elements in the references is in error as a matter of law.

32. Although the other dependent claims were similarly not correctly analyzed, Appellant relies on claims 15, 16, 18, 19, 2, 3 and 4 for purposes of establishing patentability of the claims in this paper, and the other claims are allowable for at least the same reasons.

GROUND 4: THE BOARD INCORRECTLY FINDS A BASIS TO COMBINE TEACHINGS OF AMOS AND RICHARDSON BASED ON AN INCORRECT UNDERSTANDING OF THE FIELD OF THE INVENTION VS. THE FIELDS OF THE AMOS REFERENCE AND THE RICHARDSON REFERENCE.

33. The present patent application discusses the present invention as follows:

> Automated note and coin counting equipment is used in bank vaults and other locations for both sorting and counting deposits. Note and coin counters can also be used by tellers to verify the value of transactions prior to issuing a receipt to a customer. (Para. 0003, lines 4-8.)

> The invention is particularly applicable to small stand-alone systems requiring one or more cash handling devices and/or peripheral input/output devices. (Para. 0008, lines 6-8.)
>
> Although a number of applications of the present invention are possible, one application of the present system is in the field of banking. One common banking application involves a teller receiving a deposit from a customer. (Para. 0023, lines 1-4)

34. A salient difference between the field of the present invention and Amos is that Amos is accepting and dispensing small volumes of cash relative to consumers. The present invention involves devices capable of handling large amounts of cash over a short period of operation in which the equipment is operated by a teller or employee and not a consumer. There are no consumers using the present claimed invention. It is an arrangement of equipment within a bank or retail establishment for bulk processing of cash. The Board's decision totally fails to understand the differences between the two product areas and the motivations regarding equipment to serve these different product areas, even aside from how these facts might be applied after the anticipated decision in *KSR International Co. v. Teleflex, Inc., supra*.

35. The Board's reasons for combining the applied references are incorrect since the ATM environment is a customer deposit/dispensing environment which is not a bulk cash handing environment managed by a bank or retail employee. Richardson on the other hand is drawn from the personal computer field and is not related to any cash handling environment.

36. In summary, the Board has failed to make our a *prima facie* case of obviousness under 35 U.S.C. 103, and also failed to

provide a credible basis for combining these references in the rejection.

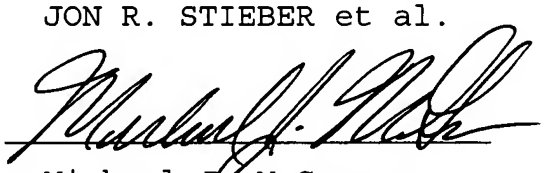
CONCLUSION

There was clearly insufficient prior art to make the rejection under 35 U.S.C. 103(a) for the claims on appeal.

Therefore, Appellants respectfully request that the rejection under 35 U.S.C. 103(a) be withdrawn and that claims 2-9 and 15-21 be allowed.

Respectfully submitted,

JON R. STIEBER et al.

By: 

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